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Paper No. 9



Carl B. Horton
General Electric Company
41 Woodford Avenue
Plainville, CT 06062

In re Application of
Roger Castonguay, et al
Application No. 09/275,066
Filed: March 23, 1999
Attorney Docket No. 41PR-7566

:
: DECISION ON PETITION UNDER
: 37 CFR 1.183 SEEKING WAIVER
: OF REQUIREMENTS UNDER 37 CFR
: 1.98

This is a response to a May 31, 2000 Petition Under 37 CFR 1.183, requesting relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98 in view of the need to file multiple applications relating to different aspects of a particular invention. The petition under 37 CFR 1.183, is requesting relief from the § 1.98 provision which requires filing paper copies of U.S. patent references in each of many related applications where the U.S. patents are being cited by Petitioner.

The petition under 37 CFR 1.183 re the submission of 3 paper copies of U.S. patent IDS citations is Granted to the extent set forth below.

The Decision is set forth in four parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.183 - Paper Copies
- Part III. Summary
- Part IV. Further Correspondence

Part 1. Background

The instant application filed under 35 U.S.C. 111 is one of about 90 U.S. applications (either filed or to be filed) relating to different aspects of an invention. An Information Disclosure Citation List has been submitted that lists 170 U.S. patents and 51 foreign patent documents for a total of 221 citations. Additionally, a list of related cases has been supplied containing 64 U.S. applications (Appendix I of the petition). Almost all the applications that have been classified have been classified in one particular art unit. Copies of all foreign references have been

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submitted in each of the filed applications (petition, page 1, 1.b.).

Petitioner's recitation to "U.S. references" has been interpreted to mean U.S. patents (U.S. patent references) as opposed to including U.S. originated journal articles. 37 CFR 1.56(b)(1) requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98. 37 CFR 1.56(a).

Rather than be required to submit, via a paper copy, each U.S. patent (petition, bridge of pages 2, 3) in each application, Petitioner seeks to have:

- (1) Three complete sets of paper copies of each IDS citation submitted;
- (2) One application (the instant application) identified as a "holding" application which would contain one complete set of paper copies of references; the paper copies of U.S. patents to be submitted in only the "holding" application;
- (3) The other related pending U.S. applications, hereafter referred to as the "bulk filing" applications, be exempt from containing the paper set of U.S. patents; the bulk filing applications will contain other information, e.g., a copy of the decision on petition permitting such procedure, a copy of the Form 1449 (or equivalent), and a copy of each foreign reference (no U.S. literature references are currently identified but it is assumed that U.S. literature references would be treated similar to foreign references).

The paper references are to be submitted as a numbered compendium, which numbering will correspond to the numbering in a PTO-1449 form.

The petition does not mention how the information supplied via the compendium would be updated even though the Technology Center believes that it is intended to be updated.

Part II. Petition Under 37 CFR 1.183 - Paper Copies

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, page 600-102, right-hand column.

Paper copies: Petitioner notes that the instant application is one of 90 bulk filing applications that

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will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each U.S. patent citation brought to the attention of the Office in regard to the instant individual application, the "holding" application, not be required to be submitted in each related "bulk filing" application. Rather, it is requested that three complete sets of paper copies be permitted to be filed as a substitute for filing in each application.

Once past the initial IDS submission, the proposal is silent as to whether applicant wishes the waiver to apply to updates.

Form 1449: In addition to submission of the three sets of paper copies in the instant "holding" application, the petition proposes that each of the bulk filing applications would receive a Form 1449 listing the reference citations (petition, page 3) with reference numbering in the three copies of the reference compendium corresponding to the numbering in the Form 1449. Although not discussed in the petition it is the Technology Center's understanding that the Form 1449 (in each of the bulk filing applications) would be updated, pursuant to the time requirements of § 1.97, each time the three sets of paper copies are updated.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies of U.S. patents), the petition states that upon allowance of the instant holding application, the application can remain as the holding application (petition, page 4). An alternative not discussed in the petition is that an alternate application may be designated as the holding application.

Termination: Petitioner seeks a right of termination (petition page 4), which is to be a mutual option. Termination by the Office is to be by written notice to the attorney giving a 2 month period. Termination by Petitioner is to be by returning to compliance with 37 CFR § 1.98. The Office will accept and specifically reserve the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by Applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of U.S. patents in 90 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's

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point of view in terms of making the copies available to different examiners handling the various applications, on balance, there is seen to be sufficient benefit to justify waiver in this instance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.¹

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing applications provided that the following 8 conditions are complied with:

- 1) Three paper copies of each IDS citation are or have been submitted to the Office;
- 2) Each (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;
- 3) The information is or has also been cited in the holding application;

Note: Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

- 4) A copy of this Decision is filed in each bulk filing application for which waiver is requested;

¹The waiver being granted in this instance is not intended to set a general precedent where there is more than one application containing related subject matter. The Office, however, intends to use the instant grant to study whether the opportunity for waiver can be extended to other applicants in similar circumstances, and whether a more general program can be announced. One factor that will be considered is the extent to which relevant information (that may not be necessarily required by § 1.56(b) but which would nonetheless be useful to the examiner, e.g., §§ 1.56(a)(1) and (2)), is submitted rather than huge dumps of nonrelevant or marginally relevant information.

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- 5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.
- 6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.
- 7) The grant of the § 1.183 petition re § 1.98(a)(2) does not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant holding application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications,² or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.
- 8) There will be no waiver of any aspects of 37 CFR 1.98 in any application after allowance or final rejection of that application.

Part III. Summary

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted, however, the following is not agreed to:

²The patent file can be kept in the Technology Center for easy reference, or rather than rely upon the patent, either a reference set of paper copies (produced from the three sets of copies to be submitted) could be utilized, or the Office may decide to create Digests from the compendium.

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- the grant of a future petition under 37 CFR 1.103 for suspension from publication of the holding application should it be allowed.

Part IV. Further Correspondence

Further correspondence with respect to this matter should be addressed to Michael L. Lewis, Legal Advisor, Office of Patent Legal Administration, as follows:

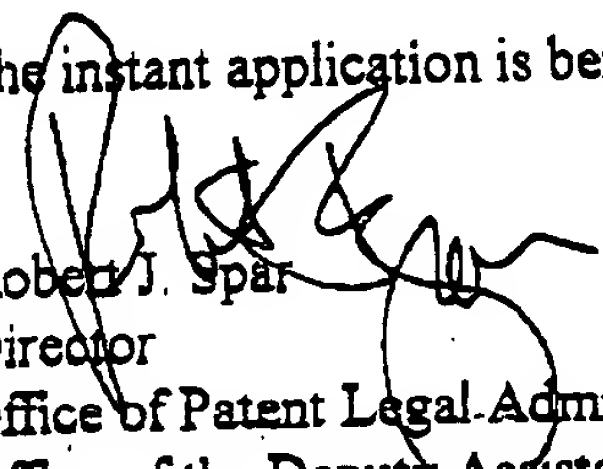
By mail: Commissioner of Patents and Trademarks
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Patent Legal Administration

By hand: Office of Patent Legal Administration
Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries specific to this matter should be directed to Mr. Lewis at (703) 306-5585.

The instant application is being forwarded to the Technical Center for further action on the merits.


Robert J. Spar
Director

Office of Patent Legal Administration
Office of the Deputy Assistant Commissioner
for Patent Examination Policy